

### **DRAWING CHANGES**

The objections of the official draftsman are noted and appreciated. However, as evidenced by the Patent Application Transmittal filed with this application, the drawings were declared to be informal. Upon a notice of allowance, formal drawings will be submitted. The formal drawing will address the issues noted by the official draftsman. No new matter has been or will be added.

### **REMARKS**

The Office Action dated January 3, 2002, and the references cited therein have been carefully considered. Responsive to the Office Action of January 3, 2002, please consider the following remarks. In view of the following remarks, the applicants submit that all pending claims are in condition for allowance.

### **REJECTION UNDER 35 U.S.C. § 103(A)**

**Claims 1, 2, 4, 6-8, 17-19, 21, 24, 33, 35, 37, 38, 46, 48, 50, 51, 59 and 60**

The office action rejected claims 1, 2, 4, 6-8, 17-19, 21, 24, 33, 35, 37, 38, 46, 48, 50, 51, 59 and 60<sup>1</sup> under 103(a) as being unpatentable over Itkis. The applicant respectfully traverses the rejection. Reconsideration is respectfully requested.

The claimed device in each of independent claims 61, 72, 92 and 106 (which are similar to rejected claims 1, 12, 32 and 46) discloses a gaming machine that includes a user input device comprising a virtual object, said virtual object being shaped like an object, to point on a display device where an image on the display device is modified in response to the user pointing the virtual object at a portion of the display device.

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<sup>1</sup> Claim 32 is listed as being rejected on the office action summary, however, it is not specifically addressed in the detailed action. From the context of the detail action paragraph 9, the applicant assumes independent claim 32 was meant to be addressed with the other independent claims in paragraph 8 (page 3).

Itkis apparently discloses a game network, including a master game device and a number of slave game devices where the master and slave devices are connected via a communication network. Apparently, an operator controls the master device and a player uses a slave device. Also, it appears a player can select items using a touch screen or by using a light pen and the selected item can be crosshatched to indicate the selection by the player (Col. 4, lines 57-63). Itkis appears to be primarily concerned with the master-slave relationship of the game devices where one or a number of different players at different slave machines can play against a single master game device.

The Office Action states "Itkis discloses that the controller is programmed to cause the images to be modified in response to the user pointing the virtual object at a portion of the display device. (Col. 4, 55-64). Crosshairs (32) are displayed on one of the images on the screen in response to the user pointing the input device at a portion of the display device. This is a virtual indicator that is displayed in response to the user selecting a selectable item." Each of the independent claims of the application call for "said images to be modified in response to the user pointing the virtual object at a portion of the display device." Itkis does not disclose images being changed merely in response to the user pointing the virtual object at a portion of the display device but discloses images changing in response to being selected, not merely being pointed at as claimed in the current invention. See col. 3, lines 62-65; col. 4, lines 59-61, which indicate images are modified only when they are selected.

The examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more, the applicant is entitled to grant of the patent. See, In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992) (italics original).

The office action has failed to produce a *prima facie case* of unpatentability because a key element, indicating a user pointing at an image by changing the image on the display, is not present or suggested by Itkis. The distinction between changing an image in response to being selected and changing an image in response to being pointed at is important to the claimed device. As it may not be obvious what the virtual object is used for or that it even is an input means, images on the video display are modified when the virtual object is pointed at them to indicate to the user that the virtual object is an input means. Accordingly, a user can track where the virtual object is pointing as it moves across the video display thereby alerting the user that the virtual object is an input device. There is no suggestion for such tracking of the pointing of the input device in Itkis because it is obvious to any user that a light pen is an input device.

In addition, M.P.E.P. Section 2143.01 states: "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)." If a virtual object input device was added to Itkis, the resulting device would not work as claimed in the pending application and would not be satisfactory for its intended purpose. Because it may not be obvious that the virtual object is an input device, and because Itkis only modifies objects when they are selected, a user likely would not even know the virtual object is an input device unless the user happened to select an image. Accordingly, a modified Itkis would not be satisfactory for its intended purpose like the claimed invention because users would not know the virtual object was an input device.

Moreover, section 2141.02 of the M.P.E.P. states that "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention" (emphasis added). It is respectfully submitted that the modification of the

patent, where the patent specifically teaches that such modification should not be made, is manifestly improper.

Itkis teaches away from the claimed device. Because Itkis uses an intuitive, simple input device such as a touch screen or a light pen, there is no need to trace the movement of the input device across the screen. Adding the feature that images are modified when a light pen is merely pointed at them would go against the teachings of Itkis where the input device is simple and straight forward (a touch screen or a light pen). There is no need to indicate the location the user is pointing the input device because users understand that a light pen is an input device and they understand where it points. Adding such a feature would detract from Itkis as it would add an un-needed layer of complexity.

The Office Action also states Itkis discloses a "virtual input device - a light pen (Col 4, 63) that would inherently be shaped like a light pen." The applicant respectfully submits that a light pen is not a "user input device comprising a virtual object, said virtual object being shaped like an object" as in all the independent claims of the application. If the light pen was inside an object, such as a virtual revolver or a virtual magic wand, then it could be considered an object as described in the application. A light pen alone is not an object as described in the application.

The mere fact that Itkis could be modified is not sufficient to establish a prima facie case of obviousness. See Section 2143.01 of the M.P.E.P. There is no teaching or motivation in Itkis to combine its pointing device of a touch screen or a light pen with a virtual object. Itkis is concerned with the hardware of a master-slave slot machine configuration. The input object is an afterthought to Itkis and is not important to Itkis. All that is important in Itkis is that a user can input information and Itkis discloses inputting information using either a touch screen or a light pen. There is no suggestion to modify Itkis to enclose the light pen inside an

object because Itkis is merely concerned with a player inputting information, not enclosing the light pen a novel object to attract users and add excitement to a game.

The application cannot be obvious in view of Itkis because the independent claims of the application (61, 77, 92 and 106) have at least two elements that are not mentioned or suggested in Itkis, because Itkis teaches away from the claimed unit and because the modified Itkis would not be satisfactory for its intended purpose. Further, because claims 62, 64, 66-68, 77, 79, 81, 84, 93, 95, 97, 98, 108, 110, and 111 (which are similar to rejected claims 2, 4, 6-8, 17, 19, 21, 24, 33, 35, 37, 38, 48, 50 and 51), are dependent from the independent claims, they also are not obvious in view of Itkis.

#### **Claims 13-16, 29-31, 43-45 and 56-58**

The office action rejected claims 13-16, 29-31, 43-45 and 56-58 under 35 USC 103(a) as being unpatentable over Itkis as applied to claims 1, 17, 32 and 46 as appropriate, in view of Yamazaki, U.S. patent 6,251,011 ("Yamazaki"). Added claims 73-76, 89-91, 103-105 and 116-118 are similar to rejected claims 13-16, 29-31, 43-45 and 56-58, respectively. The applicant respectfully traverses the rejection. Reconsideration is respectfully requested.

As explained in relation to the independent claims of the application (61, 77, 92 and 106) above, the application cannot be obvious in view of Itkis because the independent claims have at least two elements that are not mentioned or suggested in Itkis, because Itkis teaches away from the claimed unit and because the modified Itkis would not be satisfactory for its intended purpose. Itkis is not concerned with and does not suggest adding a firearm as an input device as apparently disclosed in Yamazaki.

### **Claims 3, 20 and 47**

The office action rejected claims 3, 20 and 47 under 35 USC 103(a) as being unpatentable over Itkis as applied to claims 1, 17 and 46 and further in view of Halic (U.S. Patent no. 5,700,195) and Hara et al. (U.S. patent no. 5,027,415).<sup>2</sup> Added claims 63, 80 and 107 are similar to rejected claims 3, 20 and 47. The applicant respectfully traverses the rejection. Reconsideration is respectfully requested.

As explained in relation to the independent claims of the application (61, 77, 92 and 106) above, the application cannot be obvious in view of Itkis because the independent claims have at least two elements that are not mentioned or suggested in Itkis, because Itkis teaches away from the claimed unit and because the modified Itkis would not be satisfactory for its intended purpose. Itkis is not concerned with and does not suggest adding a bill acceptor and discriminator as apparently disclosed in Hamic and Hara.

### **Claims 5, 22, 36 and 49**

The office action rejected claims 5, 22, 36 and 49 under 35 U.S.C 103(a) as being unpatentable over Itkis as applied to claims 1, 17, 32 and 46 in view of Pendergrass, Jr. (U.S. patent no. 5,565,148). Added claims 65, 82, 96 and 109 are similar to rejected claims 5, 22, 36 and 49. The applicant respectfully traverses the rejection. Reconsideration is respectfully requested.

As explained in relation to the independent claims of the application (61, 77, 92 and 106) above, the application cannot be obvious in view of Itkis because the independent claims have at least two elements that are not mentioned or suggested in Itkis, because Itkis teaches away from the claimed unit and because the modified Itkis would not be satisfactory

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<sup>2</sup> Applicant notes claim 34 was listed as rejected in the summary action but was not addressed in the detailed action. Applicant assumes claim 34 was to be address along with similar claims 3, 20 and 47.

for its intended purpose. Itkis is not concerned with and does not suggest adding a scent dispenser as apparently disclosed in Pendergass, Jr.

#### **Claims 9, 25, 39 and 52**

The office action rejected claims 9, 25, 39 and 52 under 35 USC 103(a) as being unpatentable over Itkis as applied to claims 1, 17, 32 and 46 in view of DeMar et al. (U.S. Patent no. 6,270,410). Added claims 69, 85, 99 and 112 are similar to rejected claims 9, 25, 39 and 52. The applicant respectfully traverses the rejection. Reconsideration is respectfully requested.

As explained in relation to the independent claims of the application (61, 77, 92 and 106) above, the application cannot be obvious in view of Itkis because the independent claims have at least two elements that are not mentioned or suggested in Itkis, because Itkis teaches away from the claimed unit and because the modified Itkis would not be satisfactory for its intended purpose. Itkis is not concerned with and does not suggest adding a remote control as an input device as apparently disclosed in DeMar.

#### **Claims 10, 12, 26, 28, 40, 53 and 55**

The office action rejected claims 10, 12, 26, 28, 40, 53 and 55 under 35 USC 103(a) as being unpatentable over Itkis as applied to claims 1, 17, 32 and 46 in view of Ahdoot. (U.S. Patent no. 5,913,727). Added claims 70, 72, 86, 88, 100, 113 and 115 are similar to rejected claims 10, 12, 26, 40, 53 and 55. The applicant respectfully traverses the rejection. Reconsideration is respectfully requested.

As explained in relation to the independent claims of the application (61, 77, 92 and 106) above, the application cannot be obvious in view of Itkis because the independent claims have at least two elements that are not mentioned or suggested in Itkis, because Itkis teaches away from the claimed unit and because the modified Itkis would not be satisfactory

for its intended purpose. Itkis is not concerned with and does not suggest adding a helmet or glove as an input device as apparently disclosed in Ahdoot.

**Claims 11, 27, 41 and 54**

The office action rejected claims 11, 27, 41 and 54 under 35 USC 103(a) as being unpatentable over Itkis as applied to claims 1, 17, 32 and 46 in view of Yamazaki et al. (U.S. Patent no. 5,800,265). Added claims 71, 87, 101 and 114 are similar to rejected claims 11, 27, 41 and 54. The applicant respectfully traverses the rejection. Reconsideration is respectfully requested.

As explained in relation to the independent claims of the application (61, 77, 92 and 106) above, the application cannot be obvious in view of Itkis because the independent claims have at least two elements that are not mentioned or suggested in Itkis, because Itkis teaches away from the claimed unit and because the modified Itkis would not be satisfactory for its intended purpose. Itkis is not concerned with and does not suggest adding goggles as an input device as apparently disclosed in Yamazaki.

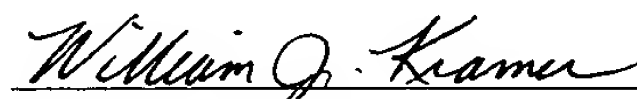
In view of the foregoing, it is respectfully submitted that all claims in the present application are in condition for allowance.

For the foregoing reasons, reconsideration and withdrawal of the rejections of the claims and allowance thereof are respectfully requested.

Respectfully submitted,

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